

REMARKS

In the application claims 7-10 and 13-27 remain pending. Claims 1-6 and 11-12 have been canceled without prejudice.

All of the pending claims presently stand rejected. The reconsideration of the rejection of the claims is respectfully requested.

In the Office Action, the drawings were objected to for failing to show “the newly introduced limitation to claims 7, 9-10, 13, and 15-17 [of] ‘data that functions to identify the consumer appliance’ and to claims 23, 26 [of] ‘data that functions to identify the make of the consumer appliance.’” In response, it is first respectfully noted that these claim elements are not “new.” Rather, these claim elements appeared in the claims as originally filed and the claims were merely amended in the previously submitted response to ensure proper antecedent bases wherever the less descriptive term “data” was used within the claims. For example, originally filed claim 7 recited “receiving at a Web server data that functions to identify the consumer appliance;” originally filed claim 13 recited “storing data that functions to identify the consumer appliance;” originally filed claim 17 recited “a memory in which is stored data that functions to identify a consumer appliance;” and originally filed claim 23 recited “a memory in which is stored data that functions to identify a make of a consumer appliance.” While the previously submitted amendment did not introduce “new” elements to the claims, it is nevertheless submitted that at least Figs. 5 and 6 of the subject application illustrate example subsystems of the hand-held device which accept data that functions to identify an appliance, e.g., to setup the hand-held device to control said appliance. Accordingly, it is respectfully submitted that the requirements of 37 CFR § 1.83(a) have been met and it is respectfully requested that the objection be withdrawn.

Similarly, it is respectfully submitted that the rejection of claims 7-10 and 13-27 under 35 U.S.C. § 112, first paragraph, must be withdrawn. In this regard, as noted above, Figs. 5 and 6 of the subject application for patent and the supporting text illustrate and describe subsystems which accept data that functions to identify an appliance, e.g., to setup the hand-held device to control said appliance. Additionally, as concerns the comment in the Office Action that “data could not function, circuits could,” it is respectfully submitted that data may indeed “function,” i.e., the data “is specially used” to identify the appliance (*see* Merriam-Webster online).

In the Office Action, pending claims stand rejected under 35 U.S.C. § 103 as being rendered obvious primarily by Allport (U.S. Patent No. 6,104,334) in view of Takechi (U.S. Patent No. 6,104,334) in further view of Freeman (U.S. Publication No. 2004/0261127). In rejecting the claims, the Office Action asserted that Allport teaches entering into a hand-held device data that functions to identify a consumer appliance and using the data at the Web server to retrieve an electronic document (IR command library) for the purpose of operating the consumer appliance and that Takechi teaches an electronic document comprising human-readable information describing how to interact with one or more controls of the consumer appliance for the purpose of operating the consumer appliance. While the Office Action acknowledged that both Allport and Takechi fail to disclose uploading the data that functions to identify the consumer appliance from the hand-held device to a Web server and using the data that functions to identify the consumer appliance, the Office Action asserted that Freeman teaches, in paras. 0137 and 0139, uploading data that functions to identify the consumer appliance from a device to a Web server. Thus, the Office Action concluded that it would have been obvious to modify the combined Takechi and Allport system “in order to allow the viewer active participation in selecting digital video streams.”

In response to this rejection, it is respectfully submitted that a rejection under 35 U.S.C. § 103 requires, among other things, that each and every element set forth in the claims be found, either expressly or inherently, in the references being relied upon. In addition, when assessing the patentability of a claimed invention, it is impermissible to break an invention into its component parts and then find a reference containing one part, another reference containing another part, etc., while using the specification of the Applicant as a template to combine these parts for the purpose of deprecating that claimed invention. Thus, to assure that such “hindsight reasoning” is not used, a rejection under 35 U.S.C. § 103 also requires a demonstration that an artisan of ordinary skill in the art at the time of the invention, with no knowledge of the claimed invention, would have selected the various parts from the references and combined them in the manner claimed.

Turning first to Allport, it is respectfully questioned how Allport can be said to disclose “entering into a hand-held device data that functions to identify a consumer appliance” and “using the data at the Web server to retrieve an electronic document (IR command library) for the purpose of operating the consumer appliance” as alleged in the Office Action *when the Office Action acknowledges that Allport does not disclose uploading the data that functions to identify the consumer appliance from the hand-held device to a Web server and using that data*. Thus, as discussed in the previously submitted response and as agreed to in the Office Action, since Allport fails to expressly describe, teach, or suggest the claimed causing data that functions to identify a consumer appliance to be uploaded from a hand-held device to a Web server which uses the uploaded data to retrieve an electronic document for the consumer appliance identified by the data, the combination of Allport, Tekechi, and Freeman simply cannot be said to expressly

include each and every element set forth in the pending claims. For this reason, a *prima facie* case of obviousness has not been established and the rejection of the claims must be withdrawn.

Considering now Freeman, while the disclosure within Freeman may use the word “upload,” nothing from within Freeman can be said to suggest uploading to a Web server the specifically recited “data that functions to identify an appliance” and using the same for any purpose. Rather, Freeman describes in paras. 0037 and 0039 nothing more than uploading user preferences, e.g., a user profile, to trigger interactive program downloading. Thus, even if one were motivated to modify the combined system of Allport and Takechi “to allow the viewer active participation in selecting digital video streams” as alleged in the Office Action (which motivation itself could not possibly lead one of ordinary skill in the art to the invention claimed), one would still only arrive at a system that uploads a user profile which is the **only** uploading that is described in Freeman. One of ordinary skill in the art would not, however, be led by the teachings within Freeman to modify the combined system of Allport and Takechi (which combination still fails to include the remaining elements set forth in the claims) to upload data to a Web server that functions to identify an appliance and using the same for the simple reason that Freeman never discloses, teaches, suggests, or even infers the desirability of this claimed concept. Thus, it is respectfully submitted that the teachings within Freeman cannot be said to demonstrate that that an artisan of ordinary skill in the art at the time of the invention, with no knowledge of the claimed invention, would have selected the various parts from the references and combined them in the manner claimed. For this reason it is submitted that the rejection under 35 U.S.C. § 103 must be withdrawn.

CONCLUSION

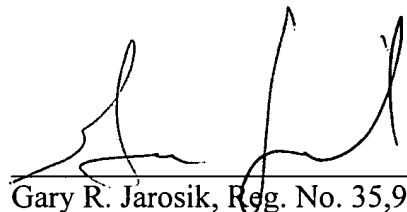
It is respectfully submitted that the application is in good and proper form for allowance. Such action of the part of the Examiner is respectfully requested. Should it be determined, however, that a telephone conference would expedite the prosecution of the subject application, the Examiner is respectfully requested to contact the attorney undersigned.

The Commissioner is authorized to charge any fee deficiency or credit overpayment to deposit account 50-2428 in the name of Greenberg Traurig.

Respectfully Submitted;

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